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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,872	12/16/2003	Michael Clark Campbell	2002-0643.01	4772
21972 7590 04/17/2008 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999				
EXAMINER				
KIM, CHONG R				
ART UNIT		PAPER NUMBER		
2624				
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04/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/736,872

**Applicant(s)**

CAMPBELL, MICHAEL CLARK

**Examiner**

CHARLES KIM

**Art Unit**

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,8-14 and 16 is/are rejected.  
7) ☒ Claim(s) 2-7 and 15 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Applicant's Submissions***

1. The submissions filed on March 5, 2008 have been entered and made of record.

### ***Finality and Allowability Withdrawn***

2. After further review and consideration of the record, the Finality of the Office action mailed October 31, 2007 is withdrawn. Moreover, the indication of allowability for claims 1-16 is also withdrawn in view of the new grounds of rejection provided below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Iguchi et al., U.S. Patent No. 6,473,153 (hereinafter Iguchi).

Referring to claim 1, Iguchi discloses a method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, the imaging apparatus having a scanner (107) and accessing a memory storing the plurality of images (111), the method comprising the steps of:

printing a thumbnail printout (P2), the thumbnail printout including a plurality of thumbnails corresponding to said plurality of images [col. 21, ll. 6-28. Note that the twelve images printed on the guide print is construed as the thumbnail printout.];

generating a selection sheet from the thumbnail printout by placing a first designation mark on the thumbnail printout for each thumbnail of the plurality of thumbnails corresponding to each image of the plurality of images on which a first action is to be taken [col. 21, ll. 29-57 and col. 22, ll. 45-67. Note that the customer is allowed to write on each image 10 of the guide print P2 on which a first action such as trimming is to be taken.];

detecting the first designation mark by scanning the selection sheet with the scanner [col. 23, ll. 1-18];

printing a confirmation for confirming to a user that each image on which the first action to be taken is designated [col. 24, ll. 5-16. Note that the photograph print P3 is printed according to the instructions provided by the user on the selection sheet. The printing of print P3 is construed as a confirmation because it confirms to the user that each image on which the first action to be taken is designated.]; and

performing the first action based on the detecting the first designation mark [col. 24, ll. 5-19. Note that the trimming is performed according to the designation marks detected on the selection sheet P2.].

Referring to claim 8, Iguchi further discloses that the step of performing the first action includes printing [col. 24, ll. 5-19. Note that the instructions from the customer also include the number of prints and print size, both of which include printing.].

Referring to claim 11, Iguchi further discloses:

the step of generating the selection sheet further includes placing a second designation mark on the thumbnail printout for each thumbnail of the plurality of thumbnails corresponding to each image of the plurality of images on which a second action is to be taken, the second designation mark being different from the first designation mark, and the second action being different from the first action [col. 16, ll. 28-43 and fig. 5. Note that a triangle M1 enclosing the number 6 is construed as the first designation mark and the upside down triangle M2 enclosing the number 1 is construed as the second designation mark. Each of these marks M1 and M2 have different corresponding actions.];

the step of detecting includes detecting both the first designation mark and the second designation mark by scanning the selection sheet with the scanner [col. 16, ll. 44-54];

the step of performing includes performing both the first action and the second action based on the detecting both the first designation mark and the second designation mark respectively [col. 16, ll. 55-65]; and

wherein the step of printing the confirmation includes printing a first confirmation mark and a second confirmation mark different from the first confirmation mark [figs. 6-7. Note that D1 in figure 6 is construed as a first confirmation mark and D2 in figure 7 is construed as the second confirmation mark.].

Referring to claim 13, Iguchi further discloses that the first designation mark has a first configuration, and the second designation mark has a second configuration different from the first configuration [fig. 5], wherein: the detecting both the first designation mark and the second designation mark includes detecting the first configuration and the second configuration

respectively [col. 16, ll. 28-54]; and performing both the first action and the second action is based on the detecting the first configuration and the second configuration respectively [col. 16, ll. 55-65].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-10, 12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iguchi and Lumley, U.S. Patent No. 7,009,726 (hereinafter Lumley).

Referring to claims 9-10, Iguchi does not explicitly disclose that the step of performing the first action includes inhibiting printing or deleting from the memory. However, these features were exceedingly well known in the art. For example, Lumley discloses that a selection sheet for photos can be created that includes the option of deleting an image from the digital media [col. 2, ll. 4-9 and fig. 1]. The Examiner notes that deleting an image would also inhibit printing.

Iguchi and Lumley are combinable because both are concerned with selection sheets that allow a user to designate images for image processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Iguchi to include the first actions of Lumley. The reason for doing so would have been to enhance the flexibility of the method by providing the user with a variety of image processing options, including deleting and

inhibiting printing, for the images he/she selected. Therefore, it would have been obvious to combine Iguchi with Lumley to obtain the invention as specified in claims 9-10.

Referring to claim 12, see the discussion of at least claims 8 and 10 above. Iguchi and Lumley disclose that the actions can include printing and deleting from memory.

Referring to claim 14, see the rejection of at least claim 12 above.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iguchi and Miyake, U.S. Patent No. 4,905,090 (hereinafter Miyake).

Referring to claim 16, Iguchi does not explicitly disclose an alignment sensor used for aligning a print head of the imaging apparatus.

Miyake discloses a scanning sensor (5) that is aligned to print head (6) [col. 3, ll. 3-33 and fig. 2].

Iguchi and Miyake are combinable because they are both concerned with printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Iguchi to include the alignment sensor of Miyake. The reason for doing so would have been to enhance the accuracy of the printing process by ensuring that the print head is properly aligned. Therefore, it would have been obvious to combine Iguchi with Miyake to obtain the invention as specified in claim 16.

***Allowable Subject Matter***

6. Claims 2-7, 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 571-272-7421. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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April 14, 2008